

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.: 09/709,433

Conf. No.: 4323

Filing Date: 11/13/2000

Art Unit: 2178

Applicants: Stewart et al.

Examiner: Campbell, Joshua D.

Title: SYSTEM, METHOD AND RECORDABLE
MEDIUM FOR PRINTING SERVICES OVER
A NETWORK AND GRAPHICAL USER
INTERFACE

Docket No.: 424992000200
(MIME-0003)

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicants respectfully request that a panel of experienced examiners perform a detailed review of appealable issues for the above-identified patent application pursuant to the Pre-Appeal Brief Conference Pilot Program. Applicants submit that the above-identified application is not in condition for appeal because the Office has failed to establish a *prima facie* case of obviousness based on clear legal and factual deficiencies in the rejections. Claims 12-33 are pending in this application.

Turning to the rejections, in the Final Office Action, the Office rejects claims 12-27 and 29-33 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Adamske.

Initially, Applicants submit that the 35 U.S.C. § 103(a) rejections of independent claims 12, 28 and 29 clearly are not proper and are without basis because the Office fails to establish a *prima facie* case that Adamske teaches or suggests every feature of the claimed invention. For

example, as argued in the After Final Response filed 5 June 2006, the Office fails to show that Adamske teaches the claimed generating a preview of a configured copy of the document on the server based on a print file and configuration information (claim 12). See After Final Response, pages 10-12. In particular, the Office fails to establish that Adamske teaches generating a preview based on a print file and configuration information. To this extent, the portion of Adamske relied upon by the Office expressly discusses options selected “[a]fter user 10 verifies the print preview” (Adamske, col. 6, line 58). See After Final Response, pages 11-12.

Further, Applicants submit that the 35 U.S.C. § 103(a) rejections of independent claims 17 and 31 clearly are not proper and are without basis because the Office fails to establish a *prima facie* case that Adamske teaches or suggests every feature of the claimed invention. For example, as argued in the After Final Response, the Office fails to show that Adamske teaches the claimed obtaining memo information, printing a customized memo, and delivering steps (claim 17). See After Final Response, pages 12-14. In particular, the Office fails to show that Adamske includes any discussion of the claimed customized memo. To this extent, the portion of Adamske relied upon by the Office comprises a shipping label that the Office alleges “would have to be tailored to each specific recipient, otherwise the document would be improperly shipped.” See Final Office Action, page 12. However, a shipping label would be attached to a shipping unit, rather than being included as part of a shipment. See After Final Response, page 13-14. Further, the claimed customized memo is based on customized memo information, which is distinct from the claimed plurality of delivery addresses separately obtained in the claimed invention. See After Final Response, page 14.

Further, Applicants submit that the 35 U.S.C. § 103(a) rejection of independent claims 20, 29, and 31 clearly are not proper and are without basis because the Office fails to establish a *prima facie* case that Adamske teaches or suggests every feature of the claimed invention. For example, in addition to the features argued above with respect to claim 12, as argued in the After Final Response, the Office fails to show that Adamske teaches the claimed system software that generates a print file on a client based on the document and communicates the print file to a server, wherein the print file can be directly printed by a printer (claim 20). See After Final Response, pages 14-18. In particular, the Office fails to show that Adamske teaches a printable version of the electronic document being generated on a client. See After Final Response, pages 14-18. To the contrary, in both embodiments of Adamske, the printable version is expressly generated on an application translation server (e.g., Adamske, col. 5, lines 18-19, 64-66 and col. 6, lines 49-52).

The Office relies on its own definition of a print driver program as “an interpreter between the operating system or application software and the particular make and model of printer you’re trying to talk to, or in other words a print driver is used to place the data you are working with in condition to be understood by the printing device you are using, or in other words interpreting the file into a file that can be directly printed by the printer.” Final Office Action, pages 11-12. However, this definition is clearly invalid based on the express teachings of Adamske, in which the print driver program “creates a metafile from the electronic document... [which] provides user 10 a viewable representation of how the hard copy document will look upon printing at printer 40.” (col. 6, lines 46-49). However, contrary to the Office’s proposed definition, the metafile cannot be directly printed by the printer. In sharp contrast,

Adamske expressly states that the metafile can be sent to translation server 24 where “the conversion into a printable (e.g., PostScript) version is performed as previously described.” (col. 6, lines 50-52).

Further, the Office fails to show any proper motivation for the proposed modification(s). See After Final Response, pages 18-20. In particular, the Office states that the motivation is to “reduce the processing load at the client.” Final Office Action, page 12. However, the first embodiment of Adamske (col. 4, line 61-col. 6, line 23) provides a solution in which the processing load at the client is reduced from that in the second embodiment. As a result, by its express teachings, Adamske has already addressed the motivation cited by the Office and teaches away from the Office’s proposed modifications and Applicants’ claimed invention.

Further, Applicants submit that the 35 U.S.C. § 103(a) rejection of independent claim 24 clearly is not proper and is without basis because the Office fails to establish a *prima facie* case that Adamske teaches or suggests every feature of the claimed invention. For example, in addition to the features argued above with respect to claims 12 and 20, as argued in the After Final Response, the Office fails to show that Adamske teaches the claimed means for assembling a copy based on configuration information. In support of its rejection, the Office states that Adamske allegedly discloses “style options”. However, Applicants note that the phrase “style options” does not appear anywhere in Adamske. See After Final Response, pages 20-21.

Further, Applicants submit that the 35 U.S.C. § 103(a) rejection of independent claim 28 clearly is not proper and is without basis because the Office fails to establish a *prima facie* case that Adamske and Bresnan teach or suggest every feature of the claimed invention. For example, as argued in the After Final Response, the Office fails to show that Adamske teaches an

"interface [that] provides a preview section and a printing options section that allows a user to provide configuration information (i.e. style options)". Final Office Action, page 10. In particular, Applicants note that (1) the phrase "style options" does not appear in Adamske; (2), the portion of Adamske cited by the Office is unrelated to previewing the document; and (3) the user in Adamske can only select a black and white or color printing option after the user has verified the print preview. See After Final Response, pages 22-23.

As a result, Applicants respectfully submit that the Office has failed to state a *prima facie* case of obviousness with respect to all the independent claims of the invention. With respect to the dependent claims not specifically referenced herein, Applicants submit that the Office has failed to state a *prima facie* case of obviousness based on the above arguments. Accordingly, Applicants submit that the Office has failed to state a *prima facie* case of obviousness for all of the pending claims.

Applicants respectfully submit that the application is not in condition for appeal. Should the examining panel believe that anything further is necessary to place the application in better condition for allowance or for appeal, they are requested to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,



John W. LaBatt, Reg. No. 48,301
Hoffman, Warnick & D'Alessandro LLC
75 State Street, 14th Floor
Albany, NY 12207
(518) 449-0044 - Telephone
(518) 449-0047 - Facsimile

Dated: 3 July 2006